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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/792,056	03/03/2004	Michael J. Otto	154-28553-US	4804
23770	7590	12/29/2006		
PAULA D. MORRIS MORRIS & AMATONG, P.C. 10260 WESTHEIMER, SUITE 360 HOUSTON, TX 77042-3110			EXAMINER MCAVOY, ELLEN M	
			ART UNIT	PAPER NUMBER
			1764	

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	12/29/2006	PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

## Office Action Summary

Application No.

10/792,056

Applicant(s)

OTTO ET AL.

Examiner

Ellen M. McAvoy

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-122 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-122 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 03 March 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date <u>9/15/2004; 8/25/2005</u> . | 6) <input type="checkbox"/> Other: ____.  |

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-9, 13-24, 33-35, 37-41, 47-52, 58-60, 63-67, 69-74, 79-81, 83-88, 97-103 and 111-113 are rejected under 35 U.S.C. 103(a) as being unpatentable over Fukutani (6,448,207).

Fukutani et al ["Fukutani"] discloses an aqueous metal working fluid containing water and as additives, a metal stearate including lithium stearate, a carbonate, a hydrogencarbonate, and a surfactant. See column 2, lines 18-46. The metal working fluid may further contain ethylene glycol and a rust inhibitor. The examiner is of the position that Fukutani meets the limitations of independent claims 1, 33, 47, 58, 63, 79, 97 and 111 which "comprises" at least one alkali metal fatty acid soap dispersed in a carrier fluid. The examiner is of the position that the term "carrier fluid" is broad enough to include both water and ethylene glycol. Although the prior art does not teach drilling fluids, the preamble language "lubricants for drilling fluid systems" is a statement of intended use which carries no weight in the composition claims. A preamble is generally not accorded any patentable weight where it merely recites the purpose of a process or the intended use of a structure, and where the body of the claim does not depend on the preamble for completeness but, instead, the process steps or structural limitations are able

to stand alone. See *In re Hirao*, 535 F.2d 67, 190 USPQ 15 (CCPA 1976) and *Kropa v. Robie*, 187 F.2d 150, 152, 88 USPQ 478, 481 (CCPA 1951).

***Claim Rejections - 35 USC § 103***

Claims 1-15, 19-32, 63-69 and 121 are rejected under 35 U.S.C. 103(a) as being unpatentable over Mondshine et al (3,761,410).

Mondshine et al ["Mondshine"] disclose water based drilling fluids having enhanced lubricating properties by the addition thereto of a lubricating additive, such as animal fats, vegetable oils and fatty acids, and mixtures thereof; and a water-insoluble alcohol component having 4-15 carbon atoms. Suitable vegetable oils include castor oil, soybean oils, cottonseed oils, sunflower oils and corn oils. See column 5, lines 1-10. Suitable alcohols include any water insoluble alcohol having 4-15 carbon atoms butanol, hexanol, and dodecanol. See column 5, lines 49-54. A pour point depressant may also be added to the water based drilling fluids including ethylene glycol, propylene glycol, and mixtures thereof. Mondshine teaches that the water component of the water based drilling fluids include fresh water, salt water, and sea water. See column 6, lines 50-64. The examiner is of the position that Mondshine meets the limitations of the drilling fluid of the claims since the combination of salt water/sea water and vegetable oil will result in sodium salts of the vegetable oils.

***Claim Rejections - 35 USC § 103***

Claims 1-122 are rejected under 35 U.S.C. 103(a) as being unpatentable over Clark et al (5,658,860) alone or in combination with Chesser et al (6,403,537).

Clark et al ["Clark"] disclose a well fluid emulsion having a water phase and an oil phase of a sulfurized alcohol and a naturally occurring fat, oil or derivatives thereof. Also disclosed is a method of lubricating drilling equipment used in conjunction with the drilling. Suitable naturally occurring fats and oils may be obtained from vegetable oils such as castor oil, coconut oil, corn oil, cottonseed oil, olive oil and sunflower oil. The preferred class of alcohols are glycols and polyglycols having a molecular weight in the range of about 200 to about 2000. See column 3, line 39 to column 4, line 21. Suitable fatty acids include those having a carbon chain length of 8-30 carbon atoms.

Clark teaches that derivatives of the fatty acids may be used including alkali metal derivatives. See column 5, lines 37-58. The examiner is of the position that the drilling fluid of Clark clearly meets the limitations of most of the above rejected claims.

Applicants invention differs in some depending claims by adding one or more monomers comprising acrylamide. However, Chesser et al ["Chesser"] is added to teach that drilling fluid systems conventionally contain acrylamide monomers. Having the prior art references before the inventors at the time the invention was made it would have been obvious to have added the acrylamide monomers of Chesser to the drilling fluids of Clark if the known imparted properties were so desired. It is *prima facie* obvious to combine two compositions each of which is taught by the prior art to be useful for the same purpose, here as drilling fluids, in order to form a third composition to be used for the

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very same purpose.... [T]he idea of combining them flows logically from their having been individually taught in the prior art.” In re Kerkhoven, 626 F.2d 846, 850, 205 USPQ 1069, 1072 (CCPA 1980).

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ellen M. McAvoy whose telephone number is (571) 272-1451. The examiner can normally be reached on M-F (7:30-5:00) with alt. Fridays off.

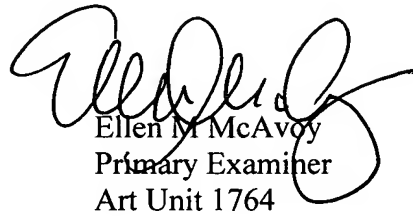
If attempts to reach the examiner by telephone are unsuccessful, the examiner’s supervisor, Glenn Caldarola can be reached on (571) 272-1444. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO

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Customer Service Representative or access to the automated information system, call

800-786-9199 (IN USA OR CANADA) or 571-272-1000.



Ellen M. McAvoy  
Primary Examiner  
Art Unit 1764

EMcAvoy  
December 22, 2006